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Filed  
4 September 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

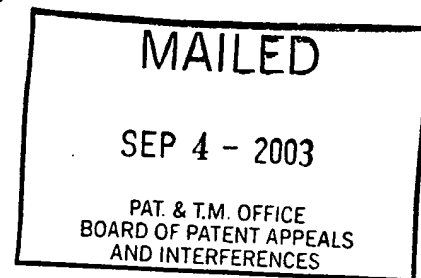


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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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GREG BENSON, GREGORY H. URICH  
and CHRISTOPHER L. KNAUFT,  
Junior Party,  
(Patent 5,845,281; Applications 09/164,606  
and 09/321,386),



v.

KARL L. GINTER, VICTOR H. SHEAR,  
FRANCES J. SPAHN and DAVID M. VAN WIE,  
Senior Party,  
(Application 09/411,205).

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Patent Interference No. 105,142

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**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**

Administrative Patent Judge Jameson Lee has been designated to handle the interference.

37 CFR § 1.610(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone conference call to set dates for taking action in the interference is scheduled for **2:00 p.m. on 21 October 2003** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See STANDING ORDER ¶ 10.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE. Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. The parties involved in this interference are:**

**Junior Party**

Named inventor: GREG BENSON, Dalby, Sweden  
GREGORY H. URICH, Lund, Sweden  
CHRISTOPHER L. KNAUFT, San Diego, CA

Patent: 5,845,281, granted 1 December 1998, based on  
application 08/594,811, filed 31 January 1996

Title: Method and system for managing a data object  
so as to comply with predetermined conditions  
for usage

Assignee: Greg Benson

Accorded Benefit: none

Attorneys: See last page

Address: See last page

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Application: 09/164,606, filed 1 October 1998

Title: Method and system for managing a data object  
so as to comply with predetermined conditions  
for usage

Assignee: Macrovision Corporation

Accorded Benefit: Patent 5,845,281, granted 1 December 1998, based  
on application 08/594,811, filed 31 January 1996

Attorneys: See last page

Address: See last page

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Application: 09/321,386, filed 27 May 1999

Title: Method and system for managing a data object  
so as to comply with predetermined conditions  
for usage

Assignee: Macrovision Corporation

Accorded Benefit: Patent 5,845,281, granted 1 December 1998, based on application 08/594,811, filed 31 January 1996; Application 09/164,606, filed 1 October 1998

Attorneys: See last page

Address: See last page

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**Senior Party**

Named Inventor: KARL L. GINTER, Beltsville, MD  
VICTOR H. SHEAR, Bethesda, MD  
FRANCIS J. SPAHN, El Cerrito, CA  
DAVID M. VAN WIE, Sunnyvale, CA

Application: 09/411,205, filed 4 October 1999

Title: System and methods for secure transaction management and electronic rights protection

Assignee: none

Accorded Benefit: Patent 6,253,193, granted 26 June 2001, based on application 09/208,017, filed 9 December 1998; Patent 5,982,891, granted 9 November 1999, based on application 08/964,333, filed 4 November 1997; Application 08/388,107, filed 13 February 1995

Attorneys: See last page

Address: See last page

## **Part F. Count and claims of the parties**

### **Count 1**

Claim 1 of Benson's Application 09/321,386 (Benson III)

The claims of the parties corresponding to Count 1 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 1-3, 5-12, 15-19 and 22-29
Ginter's Application 09/411,205:	Claims 91-93, 95-102, 105-109, 112-119, 120-122, 124-131, 134-138 and 141-148
Benson's Application 09/164,606 (Benson II):	Claims 30-32, 34-41, 44-46, 48, 51, 56, 58-66, 68 and 69
Benson's Application 09/321,386 (Benson III):	Claims 1-3, 5-12, 15-17, 19, 22, 27, 29-37 and 39-53

The claims of the parties **not** corresponding to Count 1 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 4, 13, 14, 20 and 21
Ginter's Application 09/411,205:	Claims 94, 103, 104, 110, 111, 123, 132, 133, 139 and 140
Benson's Application 09/164,606 (Benson II):	Claims 33, 42, 43, 47, 49, 50, 52-55, 57 and 67
Benson's Application 09/321, 386 (Benson III):	Claims 4, 13, 14, 18, 20, 21, 23-26, 28 and 38

## **Count 2**

Claim 4 of Benson's Application 09/321,386 (Benson III)

The claims of the parties corresponding to Count 2 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 4, 13 and 14
Ginter's Application 09/411,205:	Claims 94, 103, 104, 123, 132 and 133
Benson's Application 09/164,606 (Benson II):	Claims 33, 42, 43, 47, 49, 50, 57 and 67
Benson's Application 09/321, 386 (Benson III):	Claims 4, 13, 14, 18, 20, 21, 28 and 38

The claims of the parties **not** corresponding to Count 2 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 1-3, 5-12 and 15-29
Ginter's Application 09/411,205:	Claims 91-93, 95-102, 105-122, 124-131 and 134-148
Benson's Application 09/164,606 (Benson II):	Claims 30-32, 34-41, 44-46, 48, 51-56, 58-66, 68 and 69
Benson's Application 09/321, 386 (Benson III):	Claims 1-3, 5-12, 15-17, 19, 22-27, 29-37 and 39-53

### Count 3

Claim 23 of Benson's Application 09/321,386 (Benson III)

The claims of parties corresponding to Count 3 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 20 and 21
Ginter's Application 09/411,205:	Claims 110, 111, 139 and 140
Benson's Application 09/164,606 (Benson II):	Claims 52, 53 and 55
Benson's Application 09/321,386 (Benson III):	Claims 23 and 24

The claims of the parties **not** corresponding to Count 3 are:

Benson's Patent No. 5,845,281 (Benson I):	Claims 1-19 and 22-29
Ginter's Application 09/411,205:	Claims 91-109, 112-138 and 141-148
Benson's Application 09/164,606 (Benson II):	Claims 30-51, 54 and 56-69
Benson's Application 09/321, 386 (Benson III):	Claims 1-22 and 25-53

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See STANDING ORDER ¶ 3.5.

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Filed on behalf of [name of party] Paper \_\_\_\_<sup>1</sup>

By: Name of lead counsel  
Name of backup counsel  
Street address  
City, State, and Zip-Code  
Tel:  
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Jameson Lee)

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GREG BENSON, GREGORY H. URICH  
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Senior Party,  
(Application 09/411,205).

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Patent Interference No. 105,142

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TITLE OF PAPER

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<sup>1</sup> Leave a blank line because the board assigns the paper number.



## **Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

- ¶ 4: date for identifying lead and backup counsel.
- ¶ 5: date for identifying any real party in interest.
- ¶ 6: date for requesting copies of involved and benefit applications and patents.
- ¶ 7: date for accomplishing certain discovery.
- ¶ 8: date for filing clean copy of claims.
- ¶ 9: date for filing clean copy of claims in cases with drawings or claims containing a means plus function limitation.
- ¶ 10: date for filing list of proposed preliminary motions.
- ¶ 13.10.2: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
- ¶ 14.1.1: date for objecting to admissibility of evidence.
- ¶ 14.2: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
- ¶ 14.3: dates when cross-examination can take place.
- ¶ 15.2: dates for taking action with respect to settlement discussions.

**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**  
**Interference 105,142**

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, ZIP code and telephone number (do not list a Post Office box because file copies are sent via commercial overnight courier).

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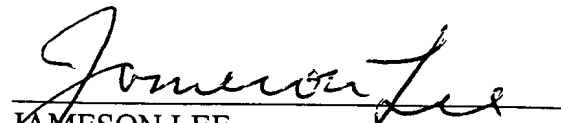
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Telephone, including area code: \_\_\_\_\_

**Part J. Signature of administrative patent judge**

  
JAMESON LEE  
Administrative Patent Judge

Date: 9/4/03

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

Copy of Patent No. 5,845,281 (Benson I)

Copy of claims of Serial No. 09/411,205

Copy of claims of Serial No. 09/164,606 (Benson II)

Copy of claims of Serial No. 09/321,386 (Benson III)

Revised May 2003

cc (via Federal Express):

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